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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JULIEN T. NGUYEN

Appeal 2009-005571
Application 10/764,835
Technology Center 2100

Decided: April 19, 2010

Before JOHN A. JEFFERY, THU A. DANG, and JAMES R. HUGHES, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 61-78. We have jurisdiction under 35 U.S.C. § 6(b), and we heard the appeal on April 13, 2010. We reverse.

STATEMENT OF THE CASE

Appellant invented a system for entering and modifying multimedia elements for communication and presentation. When an operator of a client station enters sequences of keystrokes and/or mouse actions, a particular abbreviation is detected and replaced with an associated multimedia object. *See generally* Abstract; Spec. 8:5-12; Fig. 1. Claim 61 is illustrative with the key disputed limitations emphasized:

61. A method, comprising the steps of:

receiving a set of sequences of keystrokes, mouse actions, or keystrokes and mouse actions;

detecting whether a mnemonic name is present in said sequences of keystrokes, mouse actions, or keystrokes and mouse actions, said mnemonic name being associated with one of a set of multimedia objects;

when said mnemonic name is detected in said set of sequences, *replacing said mnemonic name with said one multimedia object in said set of sequences*; and

wherein said set of multimedia objects are associated with an ensemble, said ensemble having a set of ensemble properties.

The Examiner relies on the following as evidence of unpatentability:

Liles	US 5,880,731	Mar. 9, 1999 (filed Dec. 14, 1995)
Skelly	US 6,064,383	May 16, 2000 (filed Oct. 4, 1996)
Maurille	US 6,484,196 B1	Nov. 19, 2002 (filed Mar. 20, 1998)

THE REJECTIONS

1. The Examiner rejected claims 61, 62, and 71 under 35 U.S.C. § 103(a) as unpatentable over Maurille and Skelly. Ans. 3-7.[1]
2. The Examiner rejected claims 63-70 and 72-78 under 35 U.S.C. § 103(a) as unpatentable over Maurille, Skelly, and Liles. Ans. 7-19.

THE OBVIOUSNESS REJECTION OVER MAURILLE AND SKELLY

Regarding the independent claims,[2] the Examiner finds that Maurille's instant messaging and chat functionality receives a set of sequences of keystrokes and/or mouse actions, but does not (1) detect if a mnemonic name is present in the sequence set, and (2) replace the mnemonic name with a multimedia object in the set of sequences, where the multimedia object is associated with an ensemble with properties. Ans. 4. The Examiner, however, cites Skelly as teaching this feature in concluding the claims would have been obvious. Ans. 5-7.

In reaching this conclusion, the Examiner cites Skelly's ability to automatically select a character's displayed gestures and expressions based on input text (i.e., a textual "emoticon" or acronym) in a comic chat

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[1] Throughout this opinion, we refer to (1) the Appeal Brief filed December 19, 2007; (2) the Examiner's Answer mailed March 20, 2008; and (3) the Reply Brief filed May 8, 2008.

[2] Although the Examiner's obviousness rejection over Maurille and Skelly does not include independent claim 70, it nonetheless includes claim 71 which depends from independent claim 70. *Accord* App. Br. 15 (addressing the limitations of independent claim 70 in connection with the Examiner's rejection of dependent claim 71). We therefore treat the limitations of independent claim 70 in connection with this rejection for clarity and consistency.

environment. Ans. 5-6, 20-21. According to the Examiner, substituting the appropriate "emoticon" for the corresponding text is purportedly "established and [] well known in the art" in light of this functionality. *Id.*

Appellant challenges this assertion as tantamount to an "officially noticed" fact with no evidentiary basis and, as such, the Examiner's use of official notice in this context is improper. Reply Br. 4-6. Appellant adds that Skelly does not replace any text whatsoever, but rather identifies text to "assist in decisions regarding the appearance of a comic strip element associated with the text." App. Br. 14. As such, Appellant argues, the cited prior art fails to teach or suggest replacing a mnemonic name with a multimedia object *in the set of sequences of keystrokes and/or mouse actions* as claimed. App. Br. 13-15; Reply Br. 4-6.

The issue before us, then, is as follows:

ISSUE

Under § 103, has the Examiner erred in rejecting the independent claims by finding that the cited prior art collectively would have taught or suggested replacing a mnemonic name with a multimedia object in a set of sequences of keystrokes and/or mouse actions?

This issue turns on whether the Examiner has shown that replacing input text with an appropriate "emoticon" would have been well known in the art at the time of the invention.

FINDINGS OF FACT (FF)

1. The present application is a continuation of Application Serial No. 09/053,098 filed April 1, 1998.

2. By way of background, Skelly describes a known "comic chat environment" in which users communicate with each other by inputting text via a keyboard on their respective computers, this text being visible to all participants. To this end, the system generates "comic panels" 10 which include (1) images of characters 18 associated with each user, and (2) corresponding speech balloons 14 which display text associated with that character. Skelly, col. 1, ll. 13-42; Fig. 1.

3. This system (1) maintains a set of bitmaps for each character to reflect different gestures and expressions, and (2) automatically selects a character's gestures and expressions based on the input text. Skelly, col. 1, ll. 45-49; Fig. 1.

4. To this end, the system searches for "emoticons" which are a series of characters that represent emotions (e.g., the expression ":-)" indicates happiness, while ":-(" indicates sadness). Upon finding an "emoticon," the system modifies the character's expression to indicate happiness or sadness, respectively, by assigning an appropriate displayable bitmap to that character that captures the expression. Skelly, col. 1, ll. 54-58; Fig. 1.

5. This system also searches input text to identify acronyms that may provide clues regarding a character's desired appearance (i.e., gesture and expression). For example, if the system finds the acronym "LOL" in the text (which stands for "laughing out loud"), the system concludes that the character should be laughing and generates a laughing appearance for the character. Skelly, col. 1, ll. 59-65; Fig. 1.

6. The system performs a similar technique for detected capitalized text which is interpreted as shouting. In this case, the system likewise makes the displayed character appear as if they were shouting. Skelly, col. 1, l. 66 – col. 2, l. 4; Fig. 1.

7. Appellant's Specification notes that "[e]ach abbreviation 115 includes a selected sequence of keystrokes (such as typed characters) and/or mouse actions (such as left-button clicks, right-button clicks, and double-clicks). Spec. 7:4-6.

8. Appellant's Specification notes that multimedia objects include data elements used with multimedia presentations, such as a text, audio, graphical, picture, animation, or video elements. Spec. 7:13-16.

PRINCIPLES OF LAW

An Examiner's use of Official Notice unsupported by documentary evidence should only be taken when the facts so noticed are "capable of such instant and unquestionable demonstration as to defy dispute." *See In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970) (citations omitted). Moreover, if the Examiner's assertion of Official Notice is adequately traversed, the Examiner must provide documentary evidence in the next Office Action to maintain the rejection. Manual of Patent Examining Procedure § 2144.03(C), 8th ed., Rev. 6, Sept. 2007 ("MPEP").

"The deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense' to one of ordinary skill in the art" absent some concrete evidence in the record to support these findings. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001).

ANALYSIS

Claims 61, 62, and 71

Based on the record before us, we find error in the Examiner's obviousness rejection of claims 61, 62, and 71 over Maurille and Skelly.

At the outset, although the Examiner includes claim 71 in this rejection, it depends from independent claim 70 which was rejected over Maurille, Skelly, and Liles. *Compare* Ans. 4 *with* Ans. 7. Although the reason for this inconsistency is unclear on this record, we nonetheless deem this error harmless since the Examiner relies the same rationale for the dispositive limitation in both independent claims, namely that replacing a mnemonic name with a multimedia object in a set of sequences of keystrokes and/or mouse actions is "established and [] well known in the art" in light of Skelly's functionality. *See* Ans. 5, 13.

This reasoning, however, is unsupported on this record and is therefore problematic at best. As Appellant indicates (Reply Br. 4-6), the Examiner's assertion that substituting or replacing an "emoticon" for inputted text (Ans. 20-21) is purportedly "established" and "well known in the art" is tantamount to officially noticing this fact without supporting evidence. And while Examiners can officially notice certain facts without supporting documentary evidence, such notice should be limited to facts that are "capable of such instant and unquestionable demonstration as to defy dispute." *See Ahlert*, 424 F.2d at 1091.

That is not the case here. First, even if we assume, without deciding, that replacing certain inputted text with "emoticons" is known in the art (a finding that has not been established in any event), the Examiner has not shown that such a replacement was known *at the time of the invention*,

namely April 1, 1998, which is the effective filing date of the present application. FF 1. This evidentiary showing is particularly crucial where, as here, Appellant has challenged the Examiner's basis for this official notice (Reply Br. 4-6).[3] The Examiner, however, did not respond to this challenge apart from (1) merely reiterating the unsupported position noted above in the Answer (*see* Ans. 20-21), and (2) noting that no further action was required in response to the Reply Brief. *See* Examiner's Letter Noting the Reply Brief, mailed July 1, 2008. The Examiner's rejection is therefore problematic for that reason alone.

Second, while Skelly does constitute prior art relative to Appellant's filing date, Skelly hardly supports the Examiner's assertion regarding the recited mnemonic name replacement. As Appellant indicates (App. Br. 14), Skelly does not replace text, but merely identifies certain text strings (e.g., "emoticons," acronyms, and capitalized text) that are communicated by users who are visually represented by images of "characters" in a "comic chat environment." *See* FF 2-6. These strings are then used to automatically select particular images of a displayed character corresponding to bodily gestures and expressions indicated by the identified textual strings (e.g., happiness, sadness, laughing, etc.). *See id.* With this system, users can see the depicted characters' expressions change as their written chats evoke different emotional responses. *See id.*

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[3] *See* MPEP § 2144.03(C) (noting that if the Examiner's assertion of Official Notice is adequately traversed, the Examiner must provide documentary evidence to maintain the rejection); *see also Zurko*, 258 F.3d at 1385-86 (noting that deficiencies of cited references cannot be remedied by general conclusions about what is "basic knowledge" to one of ordinary skill in the art absent some concrete evidence in the record to support these findings).

Although the textual strings in Skelly (e.g., "emoticons," acronyms, etc.) are mnemonic names that are *recognized and associated with* multimedia objects, namely a set of bitmaps that reflect each character's different gestures and expressions (FF 3), there is simply no *replacement* of these mnemonic names with associated multimedia objects as claimed, let alone that this replacement occurs *in the recited set of sequences* (i.e., typed characters associated with keystrokes and/or mouse actions). *See* FF 2-7.

That Skelly displays the users' communicated text in corresponding speech balloons associated with their displayed characters (FF 2) only bolsters our conclusion that the mnemonic names in this displayed text (e.g., "emoticons", acronyms, etc.) are not replaced, but rather displayed for readability. Otherwise, users could not read the textual communications. While these textual mnemonic names may be *used* by the system to display various bodily expressions and gestures, that hardly means that these text mnemonic names are *replaced* as the Examiner seems to suggest.

Although the Examiner makes an interesting point regarding the redundancy that could occur if a textual "emoticon" (":-)") were not replaced with a corresponding multimedia object (☺)[4] (Ans. 21), the Examiner simply does not show that such a replacement was known at the time of the invention (April 1, 1998), let alone that it would have been obvious at that time to utilize such a feature in Skelly or Maurille. Nor will we engage in such an inquiry here in the first instance on appeal.

[4] This graphical symbol or "data element" fully comports with Appellant's broad definition of "multimedia object" in the Specification. *See* FF 8.

We are therefore persuaded that the Examiner erred in rejecting independent claim 61 and dependent claim 62 for similar reasons. Since independent claim 70 recites commensurate limitations, we are also persuaded that the Examiner erred in rejecting independent claim 70 (from which claim 71 depends) for similar reasons.

While claim 70 recites a system with a detector that is *capable of* performing the recited detecting and replacing functions, these functions are commensurate with the method steps which we found are not taught or suggested by the cited prior art as noted previously. Nor has the Examiner shown that functionality of the cited prior art would have been so capable of performing these functions at the time of the invention for the reasons indicated previously.

Lastly, since the Examiner has not shown that the additional cited prior art reference to Liles cures the above-noted deficiencies, we will likewise not sustain the Examiner's rejection of the claims based on this reference. Since these deficiencies are dispositive of the present appeal, we need not address Appellant's other arguments directed to claims 63-70 and 72-78 (App. Br. 19-22; Reply Br. 8-11).

CONCLUSION

The Examiner erred in rejecting claims 61-78 under § 103.

ORDER

The Examiner's decision rejecting claims 61-78 is reversed.

REVERSED

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